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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,725	11/03/2000	Andreas Tauch	P 274355 990111BT-PAT	7227
909	7590	12/02/2003	EXAMINER	
PILLSBURY WINTHROP, LLP			HUTSON, RICHARD G	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			1652	
DATE MAILED: 12/02/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/704,725	<b>Applicant(s)</b> TAUCH ET AL.	
	<b>Examiner</b> Richard G Hutson	<b>Art Unit</b> 1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2, 6 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 17, 20, 23 and 26-29 is/are allowed.
- 6) ☒ Claim(s) 6, 15, 16, 21, 22, 24, 25 is/are rejected.
- 7) ☒ Claim(s) 18 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Applicants cancellation of claims 1 and 30-32, amendment of claims 2, 6, 22, 25 and 26 and the addition of new claim 33, Paper of 8/15/2003, is acknowledged. Claims 2, 6, 15-29 are at issue and are present for examination.

Applicants' arguments filed on 8/15/2003, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

### ***Claim Objections***

Claims 18 and 33 are objected to because of the following informalities:

Claims 18 and 33 are dependent on rejected claim 2.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6, 15, 16 are rejected under 35 U.S.C. § 101 because the claimed invention is directed toward non-statutory subject matter. In the absence of the hand of man, naturally occurring plasmids are considered non-statutory subject matter.

Diamond v. Chakrabarty, 206 USPQ 193 (1980). This rejection may be overcome by amending the claims to contain wording such as "An isolated and purified plasmid ...".

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 22 and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24 and 25 are indefinite in that they are unclear and confusing in that they are each drawn to the plasmid pCRY4 of claim 23 (or claim 24 in the case of claim 25) and they each attempt to add further limitations to the plasmid of pCRY4. Any additional limitation added to the plasmid of pCRY4, by any claim is a limitation that is inherently present in the plasmid pCRY4 of claim 23, because the plasmid pCRY4 of claim 23 is a specific plasmid, which is described in applicants specification. Thus claims which are drawn to the plasmid of pCRY4 of claim 23 and attempt to add limitations, are either improperly dependent or duplicates of claim 23, since the plasmid pCRY4 cannot be modified, or it is no longer the plasmid pCRY4. The additional limitations of claims 24 and 25 are inherently present in the plasmid pCRY4, thus claims 24 and 25 are duplicates of claim 23.

Claims 21 and 22 are similarly indefinite as claims 24 and 25 above, in that they are each drawn to the plasmid pTET3 of claim 20.

With the above said, claim 24 is further unclear, because the additional limitations of claim 24, are not consistent with the plasmid of pCRY4. Is it applicants intent that the limitations of claim 24 are intended to describe the plasmid pCRY4 or the plasmid pTET3? Applicants are reminded that the some of the limitations of claim 24 appear to be specific for both pCRY4 (limitation i) and pTET3 (limitation iii), and that as discussed above any limitation of a claim dependent from claim 23 is either inherent to the plasmid of claim 23, improperly dependent from claim 23, or describes a plasmid other then plasmid pCRY4, which does not further limit the plasmid pCRY4 and is thus a duplicate of claim 23.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Richard G Hutson, Ph.D.  
Primary Examiner  
Art Unit 1652

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